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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,588	06/25/2003	Douglas H. Rollender	29250-000203/US/COA	1441
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HARNES, DICKEY & PIERCE, P.L.C.			EXAMINER	
P.O. BOX 8910			MEHRA, INDER P	
RESTON, VA 20195			ART UNIT	PAPER NUMBER
			2617	
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			12/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/602,588

Applicant(s)

ROLLENDER, DOUGLAS H.

Examiner

Inder P. Mehra

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26, 27 and 31 is/are allowed.
- 6) ☒ Claim(s) 1-25 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/25/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to application dated: 6/25/2003. Based on this application, claims 1-31 are pending.

Information Disclosure Statement

2. The information disclosure statement filed 6/25/03 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because The IDS statement pertains to application No. 09/260,734. Further, "Foreign Patent Documents are not provided. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1-3, 6-7 and 11-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of **Rollender** (U.S. Patent No. **6810261**). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

For claim 1 of instant application, Rollender, discloses, A method of transferring data in a mobile communication system, comprising: a) receiving data to be transferred to a destination entity; b) forming a first permanent identifier including routing information to a home system; c) forming an expanded second permanent identifier having a second permanent identifier portion and an expanded portion, the second permanent identifier portion including identification information for the mobile communication system, and the expanded portion including a portion of the received data; d) sending, from a communication device, at least the first permanent identifier and the expanded second permanent identifier. (see claim 1 of US Patent no. **6810261**, application no. 09/261,735).

Limitation: “the second permanent identifier portion including identification information for the mobile communication system” was eliminated from claim 1 of ‘261 in order to obviously make it broader. It has been held that the omission of an element and its

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function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also, note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art. **ELILILLY AND COMPANY v BARR LABORATORIES, INC.**, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim 1 of Patent ('261) contains every element of claim(s) 1 of the instant application and thus anticipates the claim of the instant application. Claims of the instant application therefore is/are not patentably distinct from the earlier patent claim(s) and as such is/are unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

For claim 2 of instant application, Rollender discloses, "A method of transferring data in mobile communication system, comprising: a) receiving data; b) forming a first permanent identifier including routing information to a home system; c) forming an expanded second permanent identifier having a second permanent identifier portion and an expanded portion, and the expanded portion including a portion of the received data; c) sending, from a communication device, at least the first permanent identifier and the expanded second permanent identifier, wherein the step c) forms the expanded portion to further include destination entity routing

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information indicating to which destination entity to route the expanded second permanent identifier. (see claim 12 of US Patent no. 6810261).

Limitation: “and an expanded portion” was eliminated from claim 12 of ‘261 in order to obviously make it broader. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also, note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art. ELILILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Limitation “wherein the step a) receives data from a user of the communication device” is added in claim 2 of instant application and is obviously understood by a person of ordinary skill in the art that data is received from the user of communication device.

Claim 12 of Patent (‘261) contains every element of claim(s) 2 of the instant application and thus anticipates the claim of the instant application. Claims of the instant application therefore is/are not patentably distinct from the earlier patent claim(s) and as such is/are unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

For claim 3 of instant application, Rollender discloses, “A method of transferring data in mobile communication system, comprising: a) receiving data; b) forming a first permanent identifier including routing information to a home system; c) forming an expanded second permanent identifier having a second permanent identifier portion and an expanded portion, and the expanded portion including a portion of the received data; c) sending, from a communication device, at least the first permanent identifier and the expanded second permanent identifier, wherein the step c) forms the expanded portion to further include destination entity routing information indicating to which destination entity to route the expanded second permanent identifier. (see claim 12 of US Patent no. 6810261).

Limitation: “wherein the step a) receives data from a user of the communication device” was eliminated from claim 12 of ‘261 in order to obviously make it broader. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also, note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

ELILILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Limitation “wherein the step a) receives data from an end user system including or connected to the communication device” is obvious in that end user is communicatively connected to the communication device.

Claim 12 of Patent (‘261) contains every element of claim(s) 3 of the instant application and thus anticipates the claim of the instant application. Claims of the instant application therefore is/are not patentably distinct from the earlier patent claim(s) and as such is/are unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

For claim 6 of instant application, Rollander discloses, wherein the expanded second permanent identifier is an expanded electronic serial number of the mobile station, (see claim 6 of ‘261).

For claim 7 of instant application, Rollander discloses, wherein the expanded second permanent identifier is an expanded electronic serial number of the mobile station, (see claim 6 of ‘261).

For claim 11 of instant application, Rollander discloses, “ A method of transferring data in mobile communication system; comprising: a) receiving data; b) forming a first permanent identifier including routing information to a home system; c) forming an expanded second

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permanent identifier having a second permanent identifier portion and an expanded portion, and the expanded portion including a portion of the received data; c) sending, from a communication device, at least the first permanent identifier and the expanded second permanent identifier, wherein the step c) forms the expanded portion to further include destination entity routing information indicating to which destination entity to route the expanded second permanent identifier. (see claim 12 of US Patent no. 6810261).

Limitation: “and an expanded portion” was eliminated from claim 12 of ‘261 in order to obviously make it broader. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also, note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art. ELILILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Limitation “wherein the step b) forms the first permanent identifier to further include destination entity routing information indicating to which destination entity to route the first permanent identifier” has been added by instant application. This limitation is obvious from claim 11 itself. Limitation “Forming a first permanent identifier including a portion of the received data and routing information to a home system (same as destination).

Claim 12 of Patent ('261) contains every element of claim(s) 11 of the instant application and thus anticipates the claim of the instant application. Claims of the instant application therefore is/are not patentably distinct from the earlier patent claim(s) and as such is/are unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

For claim 12 of instant application, Rollender discloses, wherein the step c) forms the expanded portion to further include destination entity routing information indicating to which destination entity to route the expanded second permanent identifier, (see claim 12 of '261.

5. Claims 4-5, 8-10 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-7 and 9-10 of **Rollender** (U.S. Patent No. 6,748,227), hereinafter, '227.

6.

For claim 4 of instant application, Rollender discloses, wherein the communication device is a mobile station, (see to claim 9 of '227).

For claim 5 of instant application, Rollender discloses, wherein the routing information includes a mobile country code and a mobile network code, (see claim 10 of '227).

For claim 8 of instant application, Rollender discloses, wherein the routing information includes a mobile country code and a mobile network code, (see claim 10 of '227).

For claim 9 of instant application, Rollender discloses, wherein the communication device forms part of a wireless communication system, (see claim 6 of '227).

For claim 10 of instant application, Rollender discloses, wherein the communication device forms part of a wireline communication system, (see claim 7 of '227).

For claim 30 of instant application, Rollender discloses, "wherein the received, data is not identification information associated with the communication device or an end user of the communication device, (see claim 8 of '227).

7. Claims 13-25 and 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 12 of **Rollender** (U.S. Patent No. 6,603,974), hereinafter, '974 in view of claim 14 of instant application. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

For claim 13 of instant application, Rollender discloses, "A method of processing permanent identifiers, comprising: a) storing at least one permanent identifier of a first type, permanent identifiers of the first type being expanded permanent identifiers; b) receiving a permanent identifier of the first type and a permanent identifier of a second type; c) determining if a predetermined portion of the received permanent identifier of the first type matches a corresponding portion in one of the stored permanent identifiers of the first type; d) sending the received permanent identifiers of the first and second types to a destination entity if the step c) determines a match exists, (see claim 1 of '974);

For claim 14 of instant application, Rollender discloses, “e) storing a permanent identifier of the second type associated with each stored permanent identifier of the first type; f) determining if the received permanent identifier of the second type matches the stored permanent identifier of the second type associated with the stored permanent identifier of the first type that the step c) determined had a corresponding portion which matched the predetermined portion of the received permanent identifier of the first type when the step c) determines a match exists; and wherein the step d) sends the received permanent identifiers of the first and second types to a destination entity associated with the received permanent identifier of the first type when the step c) determines a match exists and the step f) determines that a match does not exist”, (see claim 1 of ‘974).

Limitation: “and an expanded portion” was eliminated from claim 12 of ‘261 in order to obviously make it broader. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also, note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art. ELILILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Limitation “the received permanent identifier of the first type including identification information for the mobile communication system and data” in claim 13 of instant application has been added by instant application. This limitation is obvious from claim 11 itself. Limitation

a) of claim 13, a) above, (same as “communication system comprising ---permanent identifier of a first type”).

Claim 1 of Patent ('974) contains every element of claim(s) 13 and 14 of the instant application and thus anticipates the claim of the instant application. Claims of the instant application therefore is/are not patentably distinct from the earlier patent claim(s) and as such is/are unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

For claim 15 of instant application, Rollender discloses, “e) determining if the expanded portion of the received permanent identifier of the first type matches the expanded portion of the stored permanent identifier of the first type that the step c) determined had a corresponding portion which matched the predetermined portion of the received permanent identifier of the first type when the step c) determines a match exists; and wherein the step d) sends the received permanent identifiers of the first and second types to a destination entity associated with the received permanent identifier of the first type when the step c) determines a match exists and the step e) determines that a match does not exist”, (see claim 12 e) of '974.

Claim 12 e) of Patent ('974) contains every element of claim(s) 15 e) of the instant application and thus anticipates the claim of the instant application. Claims of the instant application therefore is/are not patentably distinct from the earlier patent claim(s) and as such is/are unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

For claim 16 of instant application, Rollender discloses, “wherein the step b) receives the permanent identifiers of the first and second types at a home system; and the received permanent identifier of the second type includes first routing information to the home system, (see claim 2 of ‘974).

For claim 17 of instant application, Rollender discloses, “ wherein the received permanent identifier of the second type further includes second routing information to a destination entity, (see claim 3 of ‘974).

For claim 18 of instant application, Rollender discloses, “wherein the step d) sends the received permanent identifiers of the first and second types to the destination entity indicated in the second routing information”, (see claim 4 of ‘974) .

For claim 19 of instant application, Rollender discloses, “ wherein the destination entity is the home system”, (see claim 5 of ‘974).

For claim 20, of instant application, Rollender discloses, “wherein the step d) sends the received permanent identifiers of the first and second types to the destination entity indicated in the second routing information, (see claim 6 of ‘974).

For claim 21, of instant application, Rollender discloses, “wherein the destination entity forms part of the home system”, (see claim 7 of ‘974).

For claim 22, of instant application, Rollender discloses, "wherein the home system forms part of a wireless communication system.", (see claim 8 of '974).

For claim 23, of instant application, Rollender discloses, "wherein the home system forms part of a wireline communication system.", (see claim 9 of '974).

For claim 24, of instant application, Rollender discloses, "e) extracting, at the destination entity, a portion of the received permanent identifiers of the first and second types as data", (see claim 10 of '974).

For claim 25 of instant application, Rollender discloses, "wherein the received permanent identifier of the first type is associated with a source of the received permanent identifiers of the first and second types", (see claim 11 of '974).

For claim 28 of instant application, Rollender discloses, "wherein the received permanent identifier of the first type is associated with a source of the received permanent identifiers of the first and second types, (see claims 2, 3 and 5 of '974).

Allowable Subject Matter

8. Claims 26-27 and 31 are allowed.

Prior Art of Record

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Raffel et al (US Pub. no. 2004/0152482) discloses, A mobile station communicates with both a cellular network, by which it is assigned a mobile identification number, and to a cordless cellular base station utilizing the same cellular frequency range and communications protocol.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Inder P. Mehra whose telephone number is 571-272-3170. The examiner can normally be reached on Monday through Friday from 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Inder Pal Mehra 11/28/07

Inder P Mehra
Examiner
Art Unit 2617

J. Feild
JOSEPH FEILD
SUPERVISORY PATENT EXAMINER